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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/348,529	07/07/1999	ALAN SLATER	CITI0109-US	5359
27510	7590	07/31/2006	EXAMINER	
KILPATRICK STOCKTON LLP 607 14TH STREET, N.W. WASHINGTON, DC 20005			FELTEN, DANIEL S	
			ART UNIT	PAPER NUMBER
			3693	

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/348,529	SLATER ET AL.	
	Examiner	Art Unit	
	Daniel S. Felten	3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-33 and 35-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-33 and 35-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's Response filed May 03, 2006 to the Office Action mailed October 28, 2005 rejecting claims 1-45 over Doggett et al (US 5,677,955) in view of Gustin (US 5,897,625) is acknowledged. Acknowledgement is also made that claims 12 and 34 were previously cancelled, and that claims 40-49 were previously added. Thus, claims 1-11, 13-33 and 35-49 are pending in the application and (by way of correction) continue to be rejected under 35 USC 103(a) over Doggett and Gustin et al (US 5,897,625) in view of each other.

Response to Arguments

Applicant's arguments filed May 03, 2006 have been fully considered but they are not persuasive. Applicant is reminded that references, in determining obviousness are not reading in isolation but for what they fairly teach in combination with prior art as a whole. In this case applicant's invention is related to the transfer and handling of printed checks and/or cash using electronic representations of the checks and/or cash. Both Doggett and Gustin describe systems and methods wherein either a paper check and/or cash is able to be scanned into an electronic and/or digital form and is processed and/or transmitted remotely in some form of transaction (see Doggett, col. 12, lines 33 to col. 13, line 54; and Gustin, col. 4, lines 9-24, and at least col. 16, lines 35-52) as recited in claims 1 and similarly in claims 24, 40 and 45. It is also submitted that references evaluated by what they suggest to one versed in the art [see *In re Bozek*, 163, USPQ 545 (CCP 1969)]. The prior office action has addressed the issue of scanning both sides of a check having written and provided motivation of the combination of Doggett and Gustin wherein it was submitted that an artisan at the time of the invention of Doggett would recognize the fact

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that paper checks and cash have writing on both sides and thus to scan both sides of the financial instrument would allow the Doggett system to store and/or transmit accurate information.

Conversely, it was submitted that Gustin discloses a banking network. It would have been obvious to an artisan at the time the invention was made to provide alternative networks (e.g., the Internet) as disclosed in Doggett as an obvious extension of Gustin to perform various transaction between parties (see the Wire transfer or Bill payment feature in Gustin). Thus such a modification would be an obvious expedient well within the ordinary skill in the art.

Furthermore, the applicant should note that claim language such as “or”, “at least one”, “can be”, “whereby” etc., are terms that suggests or makes optional, and do not require the steps to be performed or limit the scope of a claim [see MPEP 2106 & 2111.04]. Thus arguments provided involving these limitations are considered non-persuasive and therefore rejections of the aforementioned claims are maintained and resubmitted below for applicant’s convenience.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-11, 13-33 and 35-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doggett et al (US 5,677,955) and Gustin et al (US 5,897,625) in view of each other.

Doggett discloses transmitting an image of the scanned deposited check or electronic validation of deposited cash from the first location to a second location (see Doggett, col. 2, lines 51-59); *as in at least claims 1, 24, 40 and 45*

--processing a transaction at the second location with the scanned image of the deposited check or electronic validation of deposited cash, whereby pickup of said at least one of the check and cash received at the first location can be delayed or eliminated, resulting at least in cost savings or improvements in payment settlement times by processing the transaction with the scanned image at the second location (see Doggett, col. 3, ll. 19-30); *as in at least claims 1, 24, 40 and 45*

Gustin discloses receiving at a first location at least one of a check and cash having a front face and a back face (see Gustin, Fig. 13, col. 12, ll. 5-53; and col. 15, ll. 45 to col. 16, ll. 28); *as in claims 1, 24, 40 and 45,*

--scanning the front face and the back face of said at least one of the check and cash to create a deposited check or an electronic validation of deposited cash (see Gustin, figs. 13 & 14, col. 12, ll. 5 to col. 13, ll. 43; and col. 16, ll. 20-34); *as in claims 1, 24, 40 and 45,*

In view of Gustin's teaching, it would have been obvious for an artisan at the time the invention was made to employ and/or integrate into Doggett a scanner with the ability to scan both sides of a check because an artisan at the time of the invention would recognize the fact that checks (paper checks or cash) have writing and information on both sides of the financial instrument, and thus to scan both sides of the financial instrument would allow the system to store and/or transmit an accurate image. Thus to provide such a modification would be an obvious expedient well within the ordinary skill in the art.

On the other hand, Since Gustin provides a banking network via modem to perform transactions (see Gustin, col. 9, ll. 9-50). it would have been obvious to an artisan at the time the invention was made to provide alternative networks (such as the Internet) as disclosed in Doggett as an obvious extension of Gustin to perform various transactions between parties (see Doggett, fig. 3, col. 7, ll. 39 to col. 8, ll. 32). Thus such a modification would have been well within the ordinary skill in the art as well as an obvious expedient.

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Conclusion

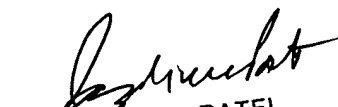
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Felten whose telephone number is (571) 272-6742. The examiner can normally be reached on Flex.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DSF
7/21/2006


JAGDISH N. PATEL
PRIMARY EXAMINER

Daniel S Felten
Examiner
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